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In re Application of:	:	
Katz, Gary M.	:	
Application No.: 09/776,714	:	DECISION ON PETITION
Filed: February 6, 2001	:	TO INVOKE SUPERVISORY
Attorney Docket No.: PIP-69A-KATZ	:	AUTHORITY UNDER
For: METHOD AND SYSTEM FOR TIMING	:	37 CFR §1.181
PROMOTIONS BASED ON A PRIOR	:	
RECEIPT OF PROMOTIONS	:	

This is a decision on applicant's petition under 37 CFR 1.181 filed December 9, 2008 to invoke supervisory review and withdraw the Office action mailed November 18, 2008 for failure to comply with 37 C.F.R. 1.104(c).

The petition is **GRANTED** to the extent indicated below.

A review of the file reveals that several Office actions employing the prior art reference Swix et al. (US 6,718,551) in a 35 USC 102 rejection were issued. The first, a non-final rejection, was issued on June 8, 2004, followed by a final rejection on January 7, 2005, then an Examiner's Answer on December 14, 2007, and then a non-final rejection, mailed November 18, 2008.

The two non-final rejections present a similar discussion of the teachings of Swix et al., see pages 6-7 of the Office action mailed June 8, 2004 and pages 3-4 of the action mailed November 18, 2008. The final rejection mailed January 7, 2005, parallels these actions with respect to the use of Swix under 102 at pages 6-7 therein, but adds further discussion of and citations to the reference in response to arguments on pages 9-10. The Examiner's Answer follows the content of the final rejection, note pages 10-11 of the Answer.

Petitioner requests withdrawal of the Office action mailed November 18, 2008 for failure to comply with both 37 C.F.R. 1.104(c)(1) and (c)(2).

Rule 1.104 in relevant part states:

§ 1.104 Nature of examination

...

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Initially, note that whether the examiner's position is correct on the content of the teachings of the reference with respect to the claims is an appealable issue and is not addressed herein. Further, petitioner has not presented specific reasoning as to why the Office action of November 18, 2008 fails to comply with rule 1.104(c)(1) as asserted in the relief requested on page 3 of the petition. All that is required with respect to (c)(1) is that the claims considered unpatentable be rejected, and no indication is provided that the examiner has considered these claims patentable.

However, as indicated above and by petitioner, rule 1.104(c)(2) indicates in relevant part that when "a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable", and that the "pertinence of each reference, if not apparent, must be clearly explained".

As noted above, the final rejection of January 7, 2005 provides additional discussion of and citations to Swix on pages 9-10 to support the rejection, as does the Examiner's Answer of December 14, 2007 on pages 10-11. However, the Office action of November 18, 2008 does not include or refer back to this additional content with respect to Swix relied upon by the examiner.


As a result, the pertinence of Swix has not been clearly explained in the November 18, 2008 action as per 37 C.F.R. 1.104(c)(2).

Therefore, the Office action of November 18, 2008 is hereby **WITHDRAWN**. The application will be forwarded to the Examiner for further action on the merits consistent with the decision herein.

Finally, applicant also requests as relief that the decision on this petition be made precedential or otherwise have it distributed as guidance to the examining corps. As no new policy or interpretation of the applicable rules has been established herein, no further action beyond that indicated above is taken.

SUMMARY: The petition is **GRANTED** to the extent indicated above.

Any questions regarding this decision should be directed to Robert Weinhardt at (571) 272-6633.



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RW: 10/18/09

RW